

REMARKS

Claims 1-21 are pending in this application. Applicant hereby traverses the rejections of record and requests reconsideration and withdrawal of such in view of the remarks contained herein.

Rejections Under 35 U.S.C. § 103(a)

Claims 1-21 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 6,396,598 to Kashiwagi et al. (hereinafter “Kashiwagi”) in view of European Patent EP0620937 to Schlack (hereinafter “Schlack”).

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim elements. *See* M.P.E.P. § 2143. Without conceding that the first and second criteria are satisfied, Applicant respectfully asserts that the Examiner’s rejection fails to satisfy at least the third criteria.

Claim 1 recites “a user data entry device for enabling a user to modify said generated image file.” In the Current Action the Examiner acknowledges that Kashiwagi does not teach or suggest this limitation. Instead, the Examiner relies upon Schlack, at col. 4 lines 33-43 and Fig. 1, as satisfying this limitation. *See* Current Action, pg. 3. However, Schlack merely describes a user entering text in a text input window, which is overlayed on a scanned image file. The written text is recognized by a common OCR algorithm. However, there is no teaching that the written text, which is contained in the text input window, becomes part of the scanned image file. Instead, Schlack suggests that written text become part of a separate file, i.e., a “text data file.” Schlack goes on to describe a user transferring text data within selected boxes into a text information file by touching selecting boxes to fill in a template field that is overlayed on a display. However, merely filling in template fields by selecting appropriate pre-defined boxes is

not the same as modify a generated image file, as set forth in the claim. As shown, the Examiner's proposed combination does not teach or suggest every claim limitation. Therefore, Applicant requests withdrawal of the rejection of record.

Independent claim 13 recites annotating said selected ones of said captured image data with said received user-entered data. In the Current Action, the Examiner points to Kashiwagi, at col. 11, lines 25-30, to satisfy this limitation. *See* Current Action, pg. 7. However, at the Examiner's citation Kashiwagi merely describes "a position relation calculation unit for calculating positional relation of a document with respect to an electronic memo processing apparatus. *See* Kashiwagi at col. 11, lines 25-28. Applicant respectfully submits that calculating a position relation is not the same as annotating captured image data. Moreover, as shown in Figures 1, 2, and 11 of Kashiwagi, and discussed at column 13, line 25 to column 14, line 64, the device 64 is operative to calculate a position of the memo, load a stored document, and then merge the memo and the stored document at the display unit, *see* column 15, line 21. As such, Kashiwagi does not teach annotating said selected ones of said captured image data with said received user-entered data. Moreover, Schlack is not relied upon to teach or suggest this missing limitation, nor does it do so. Thus, the Examiner's proposed combination does not teach all of the claimed limitations. Therefore, Applicant respectfully assert that for the above reasons claim 13 is patentable over the 35 U.S.C. § 103 rejection of record.

Independent claim 19 recites means for annotating said displayed selected image data with said superimposed received user-entered data. In the Current Action, the Examiner points to Kashiwagi, at figs 14 and 17, to satisfy this limitation. However, at the Examiner's citation Kashiwagi does not teach this limitation. Instead, Kashiwagi discloses a "link to other document." Also, as shown in Figures 1, 2, and 14 of Kashiwagi, and discussed at column 16, line 58 to column 17, line 53, the flowchart of Figure 14 is operative to create a memo. Kashiwagi does not teach a means for annotating said displayed selected image data with said superimposed received user-entered data. Moreover, Schlack is not relied upon to teach or suggest this missing limitation, nor does it do so. Thus, the Examiner's proposed combination

does not teach all of the claimed limitations. Therefore, Applicant respectfully assert that for the above reasons claim 19 is patentable over the 35 U.S.C. § 103 rejection of record.

Claims 2-12, 14-18, and 20-21 depend from base claims 1, 13, and 19, respectively, and thus inherit all limitations of their respective base claim. Each of claims 2-12, 14-18, and 20-21 sets forth features and limitations not recited by Kashiwagi. Thus, the Applicants respectfully assert that for the above reasons claims 2-12, 14-18, and 20-21 are patentable over the 35 U.S.C. § 102 rejection of record.

Conclusion

In view of the above, Applicant believes the pending application is in condition for allowance. Applicant believes no fee is due with this response. However, if a fee is due, please charge Deposit Account No. 08-2025, under Order No. 10003837-1 from which the undersigned is authorized to draw.

Respectfully submitted,

By: 

Michael A. Papalas
Attorney/Agent for Applicant(s)
Reg. No. 40,381
Date: November 27, 2006
Telephone No. (214) 855-8186